Attorney Docket Number: QA211

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Loriann Kazmercyk — Type or print name
Signature
Dec. 8, 2005 — Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BANVILLE ET AL.

APPLICATION NO: 09/848,694

(now U.S. Pat. 6,924,391) B2

FILED: MAY 3, 2001

FOR: ALPHA-AMINO, -THIO, -OXO SUBSTITUTED KETONES AS PHOSPHOLIPASE INHIBITORS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: Decision and Certification Branch of Patent Issue Division

REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. 1.322

Sir:

The above patent application Serial No. 09/848,694 issued as U.S. Pat. No. 6,924,391 on August 2, 2005. Applicants hereby request a certificate of correction for the errors set forth on form PTO/SB/44 attached hereto as Appendix A. Remarks regarding the corrections are set forth below on pages 2-4.

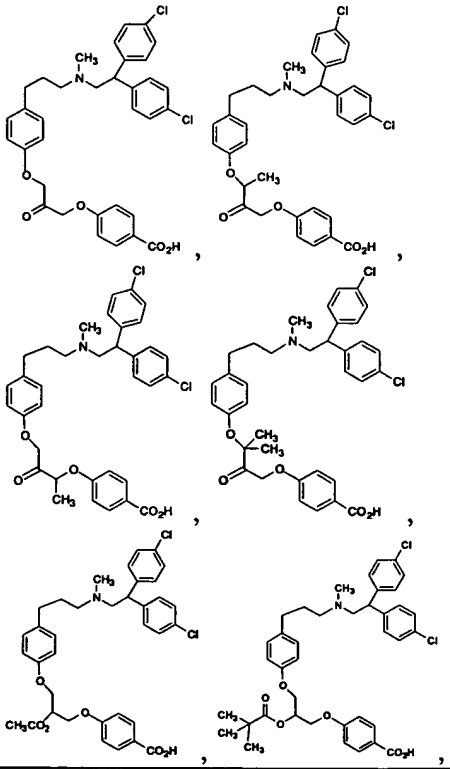
REMARKS

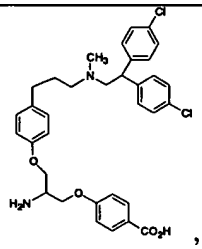
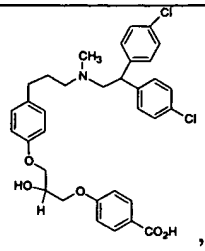
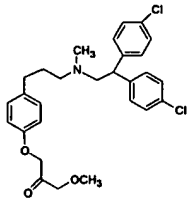
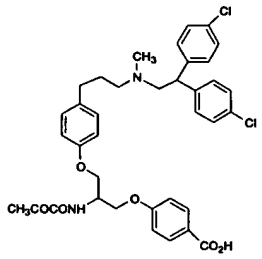
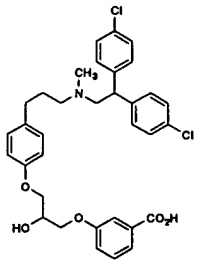
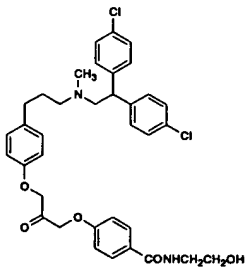
For the USPTO's convenience, Applicants have attached the following appendices:

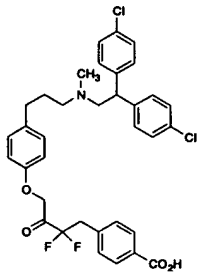
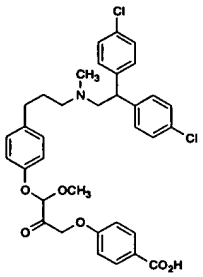
- A completed form PTO/SB/44 listing all the corrections sought to be made herein (Appendix A).
- Copies of the Office Action mailed July 8, 2004, the Amendment filed October 7, 2004 and the Notice of Allowance (Appendix B).

Each of the errors, depicted in Table 1, occurred through the fault of the USPTO, for which correction is sought under 37 C.F.R. 1.322. Applicants submit these corrections present no new matter and do not require further examination. Remarks regarding each of the corrections follow the Table.

Table 1

Error Number	Column and Page	Error	Correction
1	Col. 119, line 2	Numerous compounds are missing from claim 1.	After "A compound selected from", the following formulae should be added: 

			 ,  , and 
2	Col. 119, lines 45-65	The structure is incorrect	Replace the printed structure with the following: 
3	Col. 120, lines 25-45	The structure is incorrect	Replace the printed structure with the following: 
4	Col. 122, lines 25-45	The structure is incorrect	Replace the printed structure with the following: 

5	Col. 122, lines 45-65	The structure is incorrect	Replace the printed structure with the following: 
6	Col. 125, lines 20-40	The structure is incorrect	Replace the printed structure with the following : 

In Error 1, nine compounds were omitted from claim 1. These compounds were allowed in claim 11 of Applicants' Amendment dated October 7, 2004.[1] Applicants submit that the nine unmarked compounds shown on page 10 of the Amendment have been omitted from claim 1 of the patent and should be added to the claim following the text "A compound selected from."

Errors 2-6 consist of five structures incorrectly printed. All are USPTO mistakes. This is apparent in comparing the structures found on pages 11-12 of Applicants' Amendment with the printed patent.

As each of the mistakes made are the fault of the USPTO, Applicants believe no fees are required. If a fee is deemed to be required, the Commissioner is hereby authorized to charge such fee to Deposit Account No. 19-3880. The USPTO is requested to kindly contact the undersigned if deemed appropriate to expedite this request.

[1] On page 3 of the Office Action, mailed July 8, 2004, the Examiner states that "Claim 11 will be allowed to the extent it reads on the elected subject matter. Compounds containing Silicon and heterocyclic subject matter should be deleted." As shown on pages 9-13 of Applicants' Amendment, claim 11 was amended to remove silicon and heterocyclic subject matter which reflected the scope of the generic concept of the elected subject matter. On page 2 of the Notice of Allowance, the Examiner states that "specific compounds of claim 11 are now claimed, along with the pharmaceutical composition. These compounds do not read on the above reference and hence are patentable."

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(203) 677-7669

Pamela A. Mingo, Ph.D.
Agent for Applicant
Reg. No. 48,256

Date: December 8, 2005

APPENDIX A

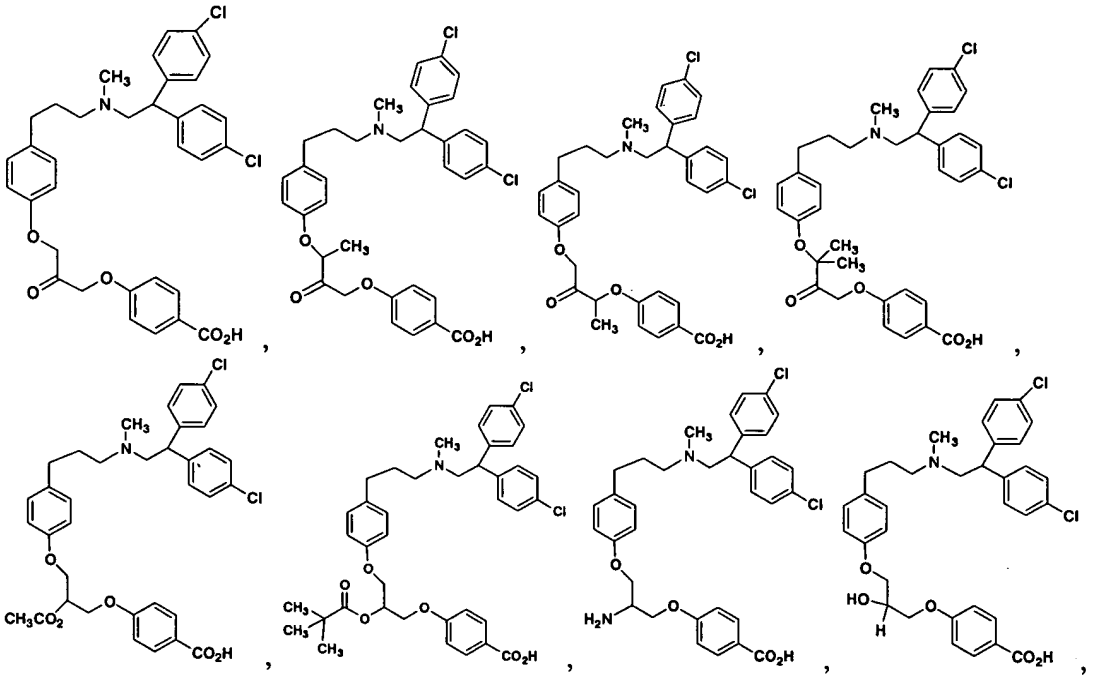
UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO : 6,924,391 B2
DATED: : August 2, 2005
INVENTOR(S) : Jacques Banville, Roger Remillard, Neelakantan Balasubramanian, Gilles Bouthillier, Alain Martel

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Col. 119, line 2, after "A compound selected from", the following formulae should be added:



MAILING ADDRESS OF SENDER:
Pamela A. Mingo, Ph.D.
Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(203) 677-7669

PATENT NO. 6,924,391

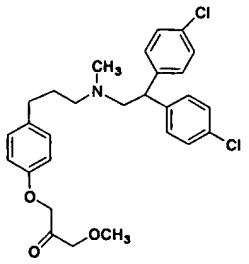
FORM PTO/SB/44

UNITED STATES PATENT AND TRADEMARK OFFICE

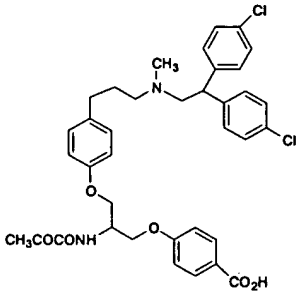
CERTIFICATE OF CORRECTION

PATENT NO : 6,924,391 B2
DATED: : August 2, 2005
INVENTOR(S) : Jacques Banville, Roger Remillard, Neelakantan Balasubramanian, Gilles Bouthillier, Alain Martel

(Continued)



Col. 119, lines 45-65, the formula should appear as follows:



MAILING ADDRESS OF SENDER:
Pamela A. Mingo, Ph.D.
Bristol-Myers Squibb Company
Patent Department
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Princeton, NJ 08543-4000
(203) 677-7669

PATENT NO. 6,924,391

FORM PTO/SB/44

DEC 16 2005

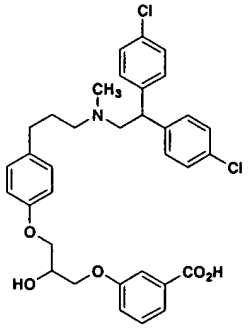
UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

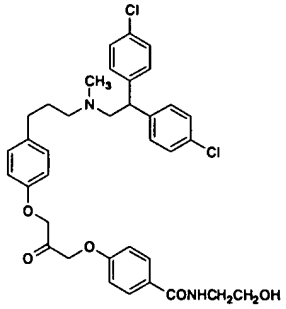
PATENT NO : 6,924,391 B2
DATED: : August 2, 2005
INVENTOR(S) : Jacques Banville, Roger Remillard, Neelakantan Balasubramanian, Gilles Bouthillier, Alain Martel

(Continued)

Col. 120, lines 25-45, the formula should appear as follows:



Col. 122, lines 25-45, the formula should appear as follows:



MAILING ADDRESS OF SENDER:
Pamela A. Mingo, Ph.D.
Bristol-Myers Squibb Company
Patent Department
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Princeton, NJ 08543-4000
(203) 677-7669

PATENT NO. 6,924,391

FORM PTO/SB/44

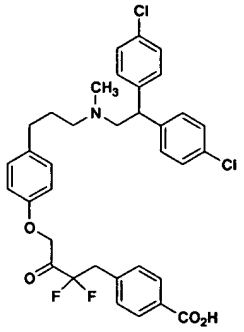
UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

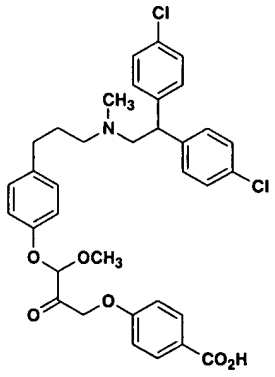
PATENT NO : 6,924,391 B2
DATED: : August 2, 2005
INVENTOR(S) : Jacques Banville, Roger Remillard, Neelakantan Balasubramanian, Gilles Bouthillier, Alain Martel

(Continued)

Col. 122, lines 45-65, the formula should appear as follows:



Col. 125, lines 20-40, the formula should appear as follows:



MAILING ADDRESS OF SENDER:
Pamela A. Mingo, Ph.D.
Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(203) 677-7669

PATENT NO. 6,924,391

FORM PTO/SB/44

APPENDIX B

QA0211
US-NP

UNITED STATES PATENT AND TRADEMARK OFFICE

OIPE IAP62
DEC 12 2005
PATENT & TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

RECEIVED
BMS PATENT LAW
OCT 26 2004

NOTICE OF ALLOWANCE AND FEE(S) DUE

7590 10/22/2004

Marla J. Mathias
Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

Docketed Item ISS PUB FEE
Due Date 1/24/05
Attorney MINGO

EXAMINER	
KUMAR, SHAILENDRA	
ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 10/22/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,694	05/03/2001	Jacques Banville	QA211	7932

TITLE OF INVENTION: ALPHA-AMINO,-THIO,-OXO SUBSTITUTED KETONES AS PHOSPHOLIPASE INHIBITORS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	$1370	$300	$1670	01/24/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

RECEIVED
NOV 03 2004
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
WALLINGFORD, CT

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,694	05/03/2001	Jacques Banville	QA211	7932

7590 10/22/2004

Marla J. Mathias
Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

EXAMINER	
KUMAR, SHAILENDRA	

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 10/22/2004

Notice of Fee Increase on October 1, 2004

If a reply to a "Notice of Allowance and Fee(s) Due" is filed in the Office on or after October 1, 2004, then the amount due will be higher than that set forth in the "Notice of Allowance and Fee(s) Due" because some fees will increase effective October 1, 2004. See Revision of Patent Fees for Fiscal Year 2005; Final Rule, 69 Fed. Reg. 52604, 52606 (May 10, 2004).

The current fee schedule is accessible from WEB site (http://www.uspto.gov/main/howtofees.htm).

If the fee paid is the amount shown on the "Notice of Allowance and Fee(s) Due" but not the correct amount in view of the fee increase, a "Notice of Pay Balance of Issue Fee" will be mailed to applicant. In order to avoid processing delays associated with mailing of a "Notice of Pay Balance of Issue Fee," if the response to the Notice of Allowance is to be filed on or after October 1, 2004 (or mailed with a certificate of mailing on or after October 1, 2004), the issue fee paid should be the fee that is required at the time the fee is paid. See Manual of Patent Examining Procedure (MPEP), Section 1306 (Eighth Edition, Rev. 2, May 2004). If the issue fee was previously paid, and the response to the "Notice of Allowance and Fee(s) Due" includes a request to apply a previously-paid issue fee to the issue fee now due, then the difference between the issue fee amount at the time the response is filed and the previously-paid issue fee should be paid. See MPEP Section 1308.01.

Effective October 1, 2004, 37 CFR 1.18 is amended by revising paragraphs (a) through (c) to read as set forth below.

Section 1.18 Patent post allowance (including issue) fees.

(a) Issue fee for issuing each original or reissue patent, except a design or plant patent:
- By a small entity (Sec. 1.27(a)) $685.00
- By other than a small entity $1,370.00

(b) Issue fee for issuing a design patent:
- By a small entity (Sec. 1.27(a)) $245.00
- By other than a small entity $490.00

(c) Issue fee for issuing a plant patent:
- By a small entity (Sec. 1.27(a)) $330.00
- By other than a small entity $660.00

Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

Notice of Allowability

Application No.	Applicant(s)	
09/848,694	BANVILLE ET AL.	
Examiner	**Art Unit**	
SHAILENDRA - KUMAR	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *10/7/04*.

2. ☒ The allowed claim(s) is/are *11 and 9(renumbered as 1-2)*.

3. ☐ The drawings filed on _____ are accepted by the Examiner.

4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some* c) ☐ None of the:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Pamela Mingo on 10/19/04.

The application has been amended as follows:

1) Claims 1-4, 7, 10, 12 and 13 have been canceled without prejudice.

2) In claim 9, line 3, "1" is changed to - - 11 - -.

2. The following is an examiner's statement of reasons for allowance: The closest prior art was JP 5-222006, especially page 5, top compound. However with the cancellation of above claims, specific compounds of claim 11 are now claimed, along with the pharmaceutical composition. These compounds do not read on the above reference and hence are patentable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHAILENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
10/19/04

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,694	05/03/2001	Jacques Banville	QA211	7932

7590 10/22/2004

Marla J. Mathias
Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

EXAMINER	
KUMAR, SHAILENDRA	

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 10/22/2004

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 367 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 367 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

PTA = 367 days

PTOL-85 (Rev. 09/04) Approved for use through 04/30/2007.

QA0211
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,694	05/03/2001	Jacques Banville	QA211	7932

7590 07/08/2004

EXAMINER
KUMAR, SHAILENDRA

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 07/08/2004

Marla J. Mathias
Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000

SEN1 (SC)

Please find below and/or attached an Office communication concerning this application or proceeding.

FINAL REJECTION

Final Review 9/8/04
Final Reject 10/8/04
Notice of App 10/8/04

Office Action Summary	Application No.	Applicant(s)	
	09/848,694	BANVILLE ET AL.	
	Examiner	Art Unit	
	SHAILENDRA - KUMAR	1621	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *29 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7 and 9-13* is/are pending in the application.

4a) Of the above claim(s) *10* is/are withdrawn from consideration.

5)☒ Claim(s) *11* is/are allowed.

6)☒ Claim(s) *1-4,9,12 and 13* is/are rejected.

7)☒ Claim(s) *7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to applicants' communication filed on 4/29/04.

Claims 1-4, 7, and 9-13 are pending in this application. Claims 5-6 and 8 have been canceled. Claim 10 has been withdrawn from the consideration, being drawn to the non-elected invention.

Rejection of claims 1-4 and 9 over Kun et al is hereby withdrawn subsequent to applicants' amendment.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 5-222006.

JP'006, page 5, lines 1-5, anticipate instant claims when, A is halo, R3, R4, R5 are H, R2 is H, W is O, and R1 is alkoxy, see page 9, Table. Inasmuch, the compound is soluble in water, the composition is anticipated. English abstract is attached along with the Japanese document.

3. Claims 7 is objected to as being dependent upon a rejected base claim, but would be allowable ***to the extent that it reads on the elected subject matter***, if rewritten in independent form including all of the limitations of the base claim and any

intervening claims. **Note applicants should delete Silicon containing subject matter**.

4. Claim 11 will be allowed to the extent it reads on the elected subject matter. Compounds containing **Silicon and heterocyclic subject matter should be deleted**.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHAILENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
7/6/04

Notice of References Cited

Application/Control No.	Applicant(s)/Patent Under Reexamination
09/848,694	BANVILLE ET AL.
Examiner	Art Unit
SHAILENDRA - KUMAR	1621

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	5-222006	08-1993	Japan	-	-
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\ copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
ates in MM-YYYY format are publication dates. Classifications may be US or foreign.

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Pamela A. Mingo
Type or print name

Pamela A Mingo
Signature

October 7, 2004
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Banville et. al

Application No.: 09/848,694

Filed: May 3, 2001

Art Unit: 1621

Examiner: S. Kumar

For: Alpha-Amino, -Thio, -Oxo Substituted Ketones as Phopholipase Inhibitors

MAIL STOP: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY AND AMENDMENT AFTER FINAL PURSUANT TO 37 C.F.R. §1.116

Sir:

This Reply and Amendment is a timely response to a Final Rejection dated July 8, 2004 having a three-month shortened statutory period for response expiring October 8, 2004. In Examiner's first Office Action dated January 5, 2004, Claims 1-4 and 9 were rejected and Claims 7 and 8 were objected to as being dependent upon a rejected base claim. Applicants canceled Claims 5,6, and 8, amended Claims 1-3, 7, and 9, and added Claims 11, 12, and 13. Applicants respectfully request reconsideration of the above-entitled application in light of the following amendments and remarks. Applicants note that a NOTICE OF APPEAL has been filed in concert with the present Reply and Amendment.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

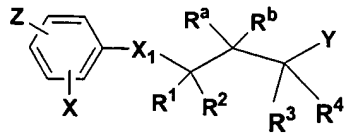
Remarks/Arguments begin on page 18 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions and listings of claims in the application:

Listing of Claims:

Claim 1. (Currently Amended) A compound of the formula



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wherein X_1 is O, $S(O)_n$, $-\overset{R^5}{\underset{|}{N}}-$, $CO-\overset{R^5}{\underset{|}{N}}-$, or $-CH_2-$, with the proviso that when X_1 is $-CH_2-$, R^1 and R^2 are only halogen;

n is 0, 1 or 2;

R^a and R^b when taken together form an oxo (=O) group, or R^a and R^b are each independently hydrogen, OH, $OCOR^9$, NH_2, N_3, $NHCOOR^9$, $NHCOCOR^9$, $NHSO_2R^9$ or F;

X is H, CF_3, OCF_3, halogen, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^1 and R^2 are each independently H, halogen, OR^9, C_1–C_7 alkyl, C_2–C_7 alkynyl,

C_2–C_7 alkenyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic~~, OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, $OC(O)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~and heteroaryl~~ being optionally substituted with one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^3, R^4 and Y are each independently H, halogen, OR^{10}, $S(O)_nR^{10}$, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, $OC(O)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~and heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^8$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~, with the proviso that not all of R^3, R^4 and Y may be the same halogen;

R^5, R^6 and R^7 are each independently H, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2-C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, OR^8, NR^8R^9, SO_3R^8, PO_3R^8, halogen, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from $COOR^8$, SO_3R^8, and PO_3R^8 ~~and heterocyclic~~;

R^8 is H, C_1–C_7 saturated straight chain alkyl or cycloalkyl;

R^9 is C_1–C_7 saturated straight chain alkyl or cycloalkyl;

R^{10} is C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being optionally substituted by

$COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic~~, OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^8$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

Z is OR^{11}, $S(O)_nR^{11}$, $NR^{11}R^{12}$ or $CHR^{11}R^{12}$;

R^{11} is C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being substituted by $NR^{13}R^{14}$, $S(O)_nR^{13}$, or OR^{13};

R^{12} is hydrogen, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being optionally substituted by $NR^{13}R^{14}$, $S(O)_nR^{13}$, or OR^{13};

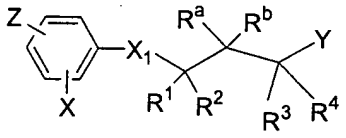
R^{13} is ~~$SiR^{15}R^{16}R^{17}$~~, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being substituted by one to three groups independently selected from $COOR^8$, OR^8, ~~$Si\,R^{15}R^{16}R^{17}$~~, OR^{15}, aryl, and biaryl ~~and heteroaryl~~, said aryl[[,]] and biaryl ~~and heteroaryl~~ being optionally substituted with one to three groups independently selected from halogen, CF_3, OR^8, $COOR^8$, NO_2, and CN;

R^{14} is H, ~~$SiR^{15}R^{16}R^{17}$~~, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being optionally substituted by one to three groups independently selected from $COOR^8$, OR^8, ~~$Si\,R^{15}R^{16}R^{17}$~~, OR^{15}, aryl, and biaryl ~~and heteroaryl~~, said aryl[[,]] and biaryl ~~and heteroaryl~~ being optionally substituted with one to three groups independently selected from halogen, CF_3, OR^8, $COOR^8$, NO_2, and CN; and ~~or~~

~~R^{13} and R^{14} when taken together with the nitrogen atom to which they are attached may form a 5–7 membered heterocyclic ring with one or more heteroatoms selected from O, N and S; said ring being optionally substituted by OR^8, $COOR^8$, or $C(O)NR^5R^6$; and~~

R^{15}, ~~R^{16}, R^{17} are each independently~~ is C_1-C_7 alkyl, aryl, benzyl, benzhydryl, biaryl, ~~heteroaryl,~~ or (C_1–C_6) alkyl–aryl ~~or (C_1–C_6) alkyl–heteroaryl,~~ said aryl, benzyl, benzhydryl, and biaryl being optionally substituted by halogen, CF_3, OR^8, $COOR^8$, NO_2, CN, or C_1-C_7 alkyl.

Claim 2. (Currently Amended) A compound of the formula



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or a pharmaceutically acceptable salt thereof wherein

X_1 is O, $S(O)_n$, $-\overset{R^5}{N}-$, $CO-\overset{R^5}{N}-$ or $-CH_2-$, with the proviso that when X_1 is $-CH_2-$, R^1 and R^2 are only halogen;

n is 0, 1 or 2;

R^a and R^b when taken together form an oxo (=O) group, or R^a and R^b are each independently hydrogen, OH, $OCOR^9$, NH_2, N_3, $NHCOOR^9$, $NHCOCOR^9$, $NHSO_2R^9$ or F;

X is H, CF_3, OCF_3, halogen, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH,

$S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^1 and R^2 are each independently H, halogen, OR^9, C_1–C_7 alkyl, C_2–C_7 alkynyl, C_2–C_7 alkenyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, $OC(O)OR^9$, aryl ~~or heteroaryl~~, said aryl ~~and heteroaryl~~ being optionally substituted with one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^3, R^4 and Y are each independently H, OR^{10}, $S(O)_nR^{10}$, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, $OC(O)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~and heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^8$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^5, R^6 and R^7 are each independently H, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2-C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, OR^8, NR^8R^9, SO_3R^8, PO_3R^8, halogen, or aryl ~~or heteroaryl~~, said aryl ~~and heteroaryl~~ being optionally substituted by one or two groups independently selected from $COOR^8$, SO_3R^8, and PO_3R^8 ~~and heterocyclic~~;

R^8 is H, C_1–C_7 saturated straight chain alkyl or cycloalkyl, CF_3 or CH_2CF_3;

R^9 is C_1–C_7 saturated straight chain alkyl or cycloalkyl;

R^{10} is C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^8$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

Z is OR^{11}, $S(O)_nR^{11}$, $NR^{11}R^{12}$ or $CHR^{11}R^{12}$;

R^{11} is C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being substituted by $NR^{13}R^{14}$, $S(O)_nR^{13}$, or OR^{13};

R^{12} is hydrogen, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being optionally substituted by $NR^{13}R^{14}$, $S(O)_nR^{13}$ or OR^{13};

R^{13} is ~~$SiR^{15}R^{16}R^{17}$~~, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being substituted by one to three groups independently selected from $COOR^8$, OR^8, ~~$Si R^{15}R^{16}R^{17}$~~, OR^{15}, aryl, and biaryl ~~and heteroaryl~~, said aryl[[,]] and biaryl ~~and heteroaryl~~ being optionally substituted with one to three groups independently selected from halogen, CF_3, OR^8, $COOR^8$, NO_2, and CN;

R^{14} is H, ~~$SiR^{15}R^{16}R^{17}$~~, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–

C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being optionally substituted by one to three groups independently selected from $COOR^8$, OR^8, ~~Si $R^{15}R^{16}R^{17}$~~, OR^{15}, aryl, and biaryl ~~and heteroaryl~~, said aryl[[,]] and biaryl ~~and heteroaryl~~ being optionally substituted with one to three groups independently selected from halogen, CF_3, OR^8, $COOR^8$, NO_2, and CN; and ~~or~~

~~R^{13} and R^{14} when taken together with the nitrogen atom to which they are attached may form a 5 – 7 membered heterocyclic ring with one or more heteroatoms selected from O, N and S; said ring being optionally substituted by OR^8, $COOR^8$, or $C(O)NR^5R^6$; and~~

R^{15}, ~~R^{16}, R^{17} are each independently~~ is C_1-C_7 alkyl, aryl, benzyl, benzhydryl, biaryl, ~~heteroaryl,~~ or (C_1–C_6) alkyl–aryl ~~or (C_1–C_6) alkyl–heteroaryl~~, said aryl, benzyl, benzhydryl, and biaryl being optionally substituted by halogen, CF_3, OR^8, $COOR^8$, NO_2, CN, or C_1–C_7 alkyl.

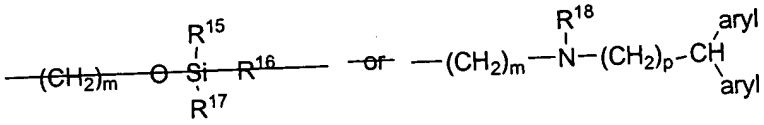
Claim 3. (Currently Amended) A compound of claim 2 wherein X_1 is O or $S(O)_n$ and Y is OR^{10} in which R^{10} is C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~or heterocyclic~~, said R^6 , R^7, R^8 and R^9 substituents being defined as in claim 2.

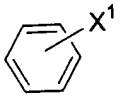
Claim 4. (Original) A compound of claim 3 in which R^a and R^b taken together represent an oxo (=O) group, or R^a and R^b are each independently hydrogen or OH.

Claims 5-6. (Canceled).

Claim 7. (Currently Amended) A compound of claim 3 in which

Z is



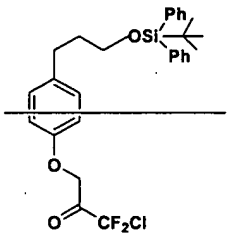
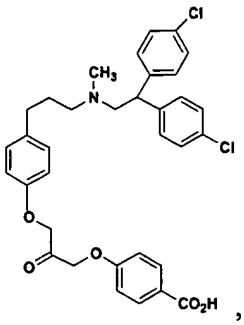
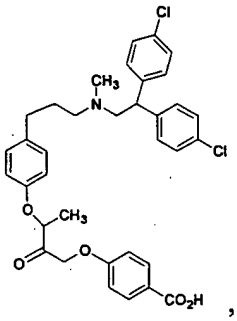
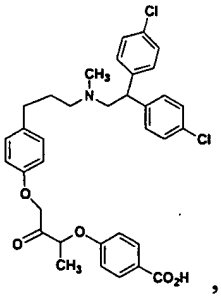
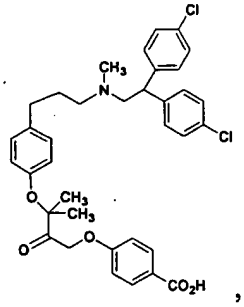
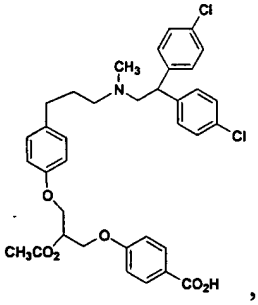
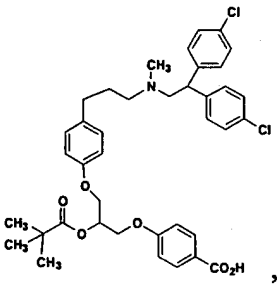
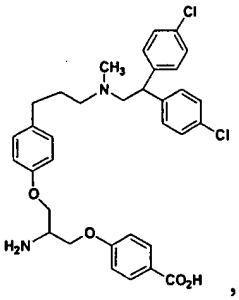
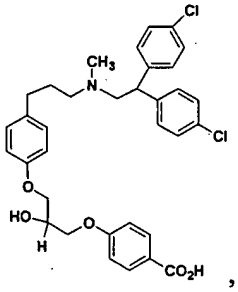
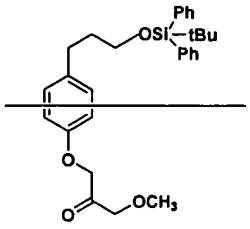
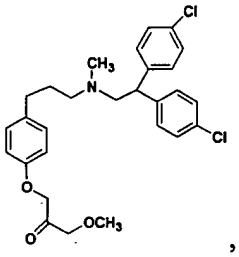
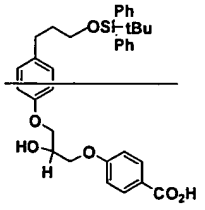
in which m and p each independently represent an integer of one to six, ~~R^{15}, R^{16}, R^{17} are each independently C_1–C_7 alkyl or phenyl,~~ R^{18} is C_1–C_7 alkyl and aryl represents  in which X^1 is halogen.

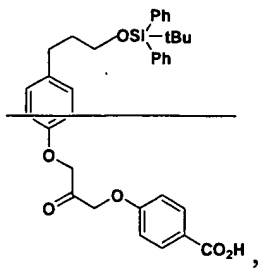
Claim 8. (Canceled).

Claim 9. (Original) A pharmaceutical composition for the inhibition of cytosolic phospholipase A_2 comprising a therapeutically effective amount of a compound of claim 1 and a pharmaceutically acceptable carrier.

Claim 10. (Withdrawn) A method of inhibiting cytosolic phospholipase A_2 in a mammal in need thereof, comprising administering to said mammal a therapeutically effective amount of a compound of claim 1.

Claim 11. (Currently Amended) A compound selected from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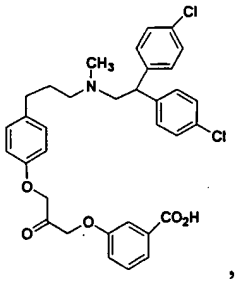
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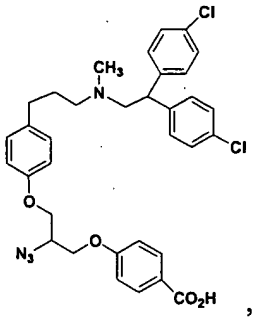
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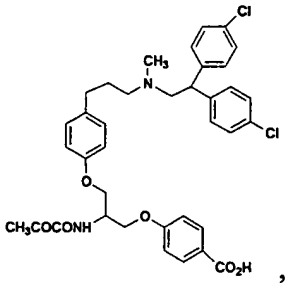
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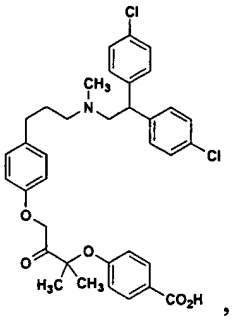
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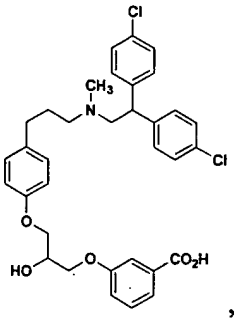
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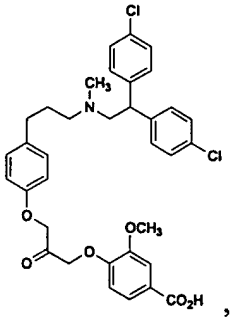
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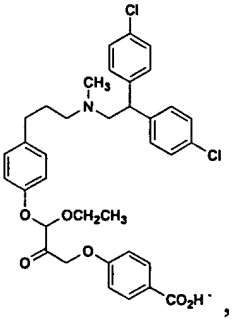
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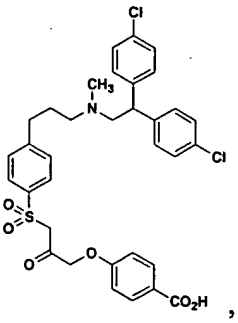
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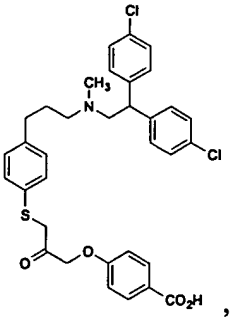
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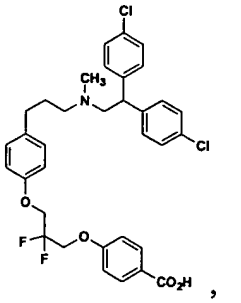
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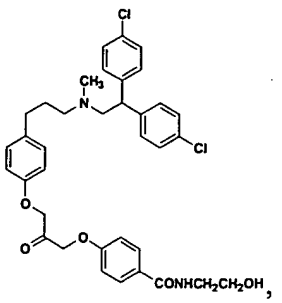

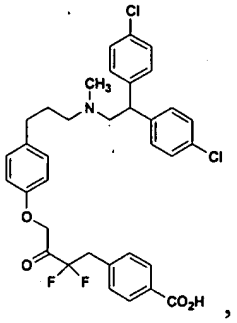
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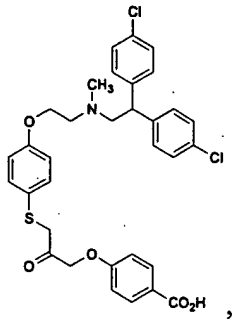
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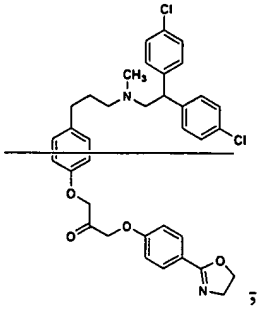
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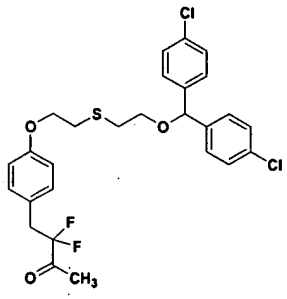
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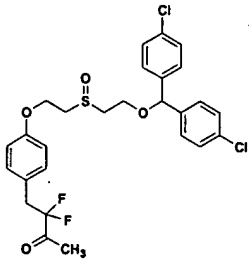
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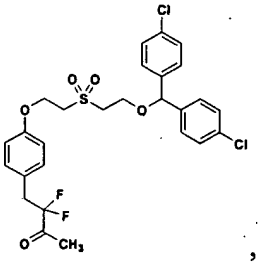
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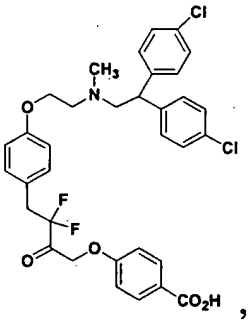
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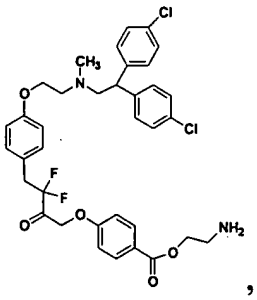
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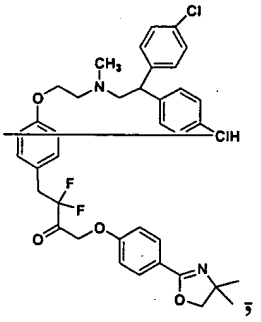
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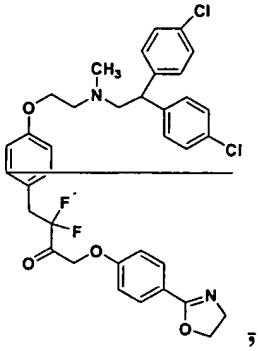
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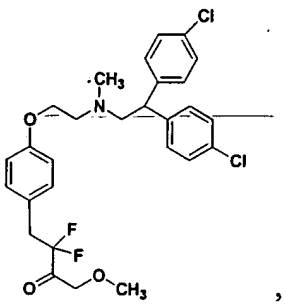
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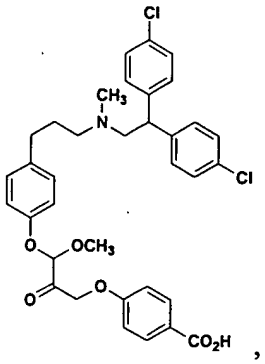
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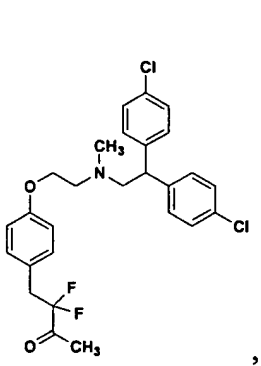
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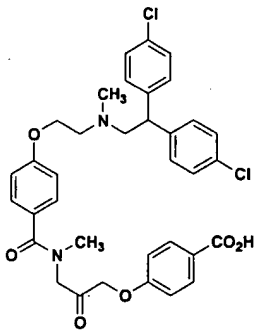
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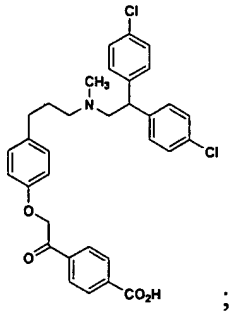
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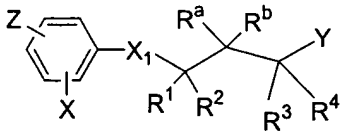
and

or a pharmaceutically acceptable salt thereof.

Claim 12. (Currently Amended) A compound of the formula



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or a pharmaceutically acceptable salt thereof wherein

X_1 is O, $S(O)_n$, $CO-\overset{R^5}{\underset{|}{N}}-$, or $-CH_2-$, with the proviso that when X_1 is $-CH_2-$, R^1 and R^2 are only halogen;

n is 0, 1 or 2;

R^a and R^b when taken together form an oxo (=O) group, or R^a and R^b are each independently hydrogen, OH, $OCOR^9$, NH_2, N_3, $NHCOCOR^9$, or F;

X is H;

R^1 and R^2 are each independently H, halogen, OR^9, or C_1-C_7 alkyl;

R^3, R^4 and Y are each independently H, halogen, OR^{10}, or C_1-C_7 alkyl, said alkyl being optionally substituted by aryl, said aryl being optionally substituted by one or two $COOR^8$ groups, with the proviso that not all of R^3, R^4 and Y may be the same halogen;

R^5, R^6, and R^7 are each independently hydrogen or C_1-C_7 alkyl, said alkyl being optionally substituted by OR^8;

R^8 is H or C_1-C_7 saturated straight chain alkyl;

R^9 is C_1-C_7 saturated straight chain alkyl;

R^{10} is C_1-C_7 alkyl or aryl, said alkyl or aryl group being optionally substituted by $COOR^8$, $C(O)NR^6R^7$, ~~heterocyclic,~~ or OR^8;

Z is OR^{11} or $CHR^{11}R^{12}$;

R^{11} is C_1-C_7 alkyl substituted by $NR^{13}R^{14}$, $S(O)_nR^{13}$, or OR^{13};

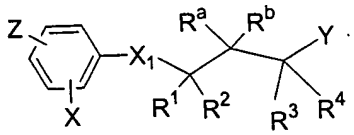
R^{12} is hydrogen;

R^{13} is ~~$SiR^{15}R^{16}R^{17}$ or~~ C_1-C_7 alkyl, said alkyl substituted by one to three groups independently selected from OR^{15} and aryl, said aryl substituted with one halogen;

R^{14} is C_1-C_7 alkyl; and

R^{15}~~, R^{16}, and R^{17} are each independently~~ is C_1-C_7 alkyl, aryl, or benzhydryl, said aryl and benzhydryl being optionally substituted by halogen.

Claim 13. (Currently Amended) A compound of the formula



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or a pharmaceutically acceptable salt thereof wherein

X_1 is O, $S(O)_n$, or $-CH_2-$, with the proviso that when X_1 is $-CH_2-$, R^1 and R^2 are only halogen;

n is 0, 1 or 2;

R^a and R^b are each independently hydrogen, OH, $OCOR^9$, NH_2, N_3, $NHCOOR^9$, $NHCOCOR^9$, or F;

X is H, CF_3, OCF_3, halogen, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl or cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl,~~ said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^1 and R^2 are each independently H, halogen, OR^9, C_1–C_7 alkyl, C_2–C_7 alkynyl, C_2–C_7 alkenyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, $OC(O)OR^9$, or aryl ~~or heteroaryl~~, said aryl and heteroaryl being optionally substituted with one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^9$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~;

R^3 and R^4 are each independently H, halogen, OR^{10}, $S(O)_nR^{10}$, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, $OC(O)OR^9$, or aryl ~~or heteroaryl,~~ said aryl ~~and heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^8$, PO_3R^8, and $C(O)NR^6R^7$ ~~and heterocyclic~~, with the proviso that not all of R^3, R^4 and Y may be the same halogen;

Y is OR^{10} or $S(O)_nR^{10}$;

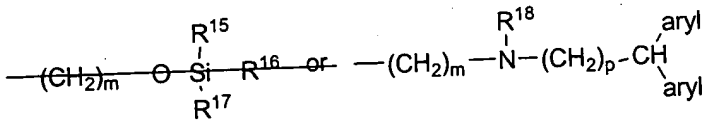
R^5, R^6 and R^7 are each independently H, C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2-C_7 alkynyl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl and cycloalkyl group being optionally substituted by $COOR^8$, CN, OR^8, NR^8R^9, SO_3R^8, PO_3R^8, halogen, or aryl ~~or heteroaryl~~, said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from $COOR^8$, SO_3R^8, and PO_3R^8 ~~and heterocyclic~~;

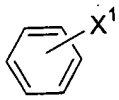
R^8 is H, C_1–C_7 saturated straight chain alkyl or cycloalkyl;

R^9 is C_1–C_7 saturated straight chain alkyl or cycloalkyl;

R^{10} is C_1–C_7 alkyl, C_2–C_7 alkenyl, C_2–C_7 alkynyl, aryl or C_3–C_7 cycloalkyl, said alkyl, alkenyl, alkynyl, aryl or cycloalkyl group being optionally substituted by $COOR^8$, CN, $C(O)NR^6R^7$, PO_3R^8, SO_3R^8, ~~heterocyclic,~~ OR^8, SH, $S(O)_nR^9$, NR^6R^7, $NH(CO)NR^6R^7$, $NH(CO)OR^9$, or aryl ~~or heteroaryl,~~ said aryl ~~or heteroaryl~~ being optionally substituted by one or two groups independently selected from NR^6R^7, OR^8, $COOR^8$, SO_3R^8, $OCOR^8$, PO_3R^8, and $C(O)NR^6R^7$ ~~or heterocyclic~~; and

Z is



in which m and p each independently represent an integer of one to six, ~~R^{15}, R^{16}, R^{17} are each independently C_1–C_7 alkyl or phenyl,~~ R^{18} is C_1–C_7 alkyl and aryl represents  in which X^1 is halogen.

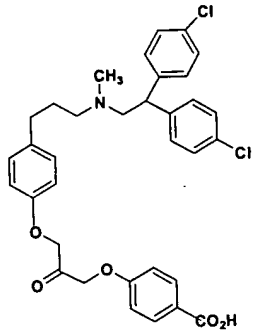
REMARKS/ARGUMENTS

Claims 1-4, 7, and 9-13 are pending in this application.

In the Office Action dated July 8, 2004, the Examiner rejected Claims 1-4, 9, 12, and 13 under 35 U.S.C. §102(b) as being unpatentable over JP 5-222006. Claim 7 was objected to as being dependent upon a rejected base claim.

Reconsideration and allowance of this application are respectfully requested in view of the above amendments and the remarks that follow.

Pursuant to the Examiner's request for an election of a single disclosed species on July 29, 2003, Applicants elected 3-[4-[3-[N-[2-Bis-(4-chlorophenyl)ethyl]-N-methylamino]propyl]phenoxy]-1-(4-carboxyphenoxy)-2-propanone which is Example 2 on page 51 of the specification.



3-[4-[3-[N-[2-Bis-(4-chlorophenyl)ethyl]-N-methylamino]propyl]phenoxy]-1-(4-carboxyphenoxy)-2-propanone

In the July 8, 2004 Office Action, the Examiner states that "Claim 11 will be allowed to the extent it reads on the elected subject matter. Compounds containing Silicon and heterocyclic subject matter should be deleted." Accordingly, Applicants have amended Claims 1, 2, 3, 7,11, 12, and 13 to remove silicon and heterocyclic subject matter which reflects the scope of the generic concept of the elected subject matter. Applicants maintain the right to file divisonal application(s) on non-elected subject matter.

Rejection of Claims 1-4, 9, 12, and 13 Under 35 U.S.C. §102(b)

The Examiner has rejected Claims 1-4, 9, 12, and 13 under 35 U.S.C. §102(b) as being unpatentable over JP 5-222006. JP'006 teaches compounds containing a

heterocycle. It is Applicants' position that the amendments to Claims 1, 2, 3, 9, 12, and 13, which remove all heterocyclic subject matter, render the rejections moot. Therefore, it is respectfully requested that the rejections to Claims 1-4, 9, 12, and 13 be withdrawn.

Objection of Claim 7 and Allowance of Claim 11

Claim 7 has been objected to as being dependent upon a rejected base claim, but would be allowable to the extent that it reads on the elected subject matter, if rewritten in independent form including all of limitations of the base claim. The Examiner further states "Note applicants should delete Silicon containing subject matter." Applicants have amended Claim 7 to remove all silicon containing subject matter and respecfully request that the objection be withdrawn.

Claim 11 is allowed to the extent it reads on the elected subject matter. The Examiner further states "Compounds containing Silicon and heterocyclic subject matter should be deleted." Applicants have amended Claim 11 to remove all silicon and heterocyclic subject matter and respectfully request that the claim be allowed.

While Applicants submit that the claims are in condition for allowance and respectfully request the Examiner's reconsideration, a NOTICE OF APPEAL has nevertheless been filed. The Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.17 which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

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Agent for Applicants
Reg. No. 48, 256

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Date: October 7, 2004

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Pamela A. Mingo
Type or print name

Pamela A. Mingo
Signature

October 7, 2004
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Banville et. al

APPLICATION NO: 09/848,694

FILED: 05/03/2001

FOR: Alpha-Amino, -Thio, -Oxo Substituted Ketones as Phopholipase Inhibitors

ART UNIT: 1621

EXAMINER: S. Kumar

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOTICE OF APPEAL

Sir:

Applicants hereby appeal to the Board of Patent Appeals and Interferences from the Office Action dated July 8, 2004 finally rejecting Claims 1-4, 9, 12, and 13.

☒ Please charge Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company in the amount of $330 for payment of the appeal fee. An additional copy of this paper is here enclosed. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

☐ The appeal fee was paid in a previous appeal herein. The examiner re-opened prosecution prior to any decision by the Board of Patent Appeals and Interferences. No fee is now due.

☐ Enclosed is a Petition for Extension of Time.

Respectfully submitted,

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Reg. No. 48,256

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Date: October 7, 2004